

Remarks

Claims 4 through 12 are presently pending.

A. Claims 4-6 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the description requirement because the Examiner asserts that there is no basis in the original specification for a metatarsal guard having no slits therein.

In Ex parte Parks, 30 USPQ2(d) 1234, 1236 (1983), the Board of Patent Appeals and Interferences held that “[c]learly, the observation of a lack of literal support does not, in and of itself, establish a prima facie case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112.” Rather, a lack of adequate descriptive support is established when “the originally-filed disclosure would not have reasonably conveyed to one having ordinary skills in the art that an appellant had possession of the now claimed subject matter.” Id. Accordingly, the Board held, “it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed, citing In re Anderson, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

In the present case, a person having ordinary skill in the art would have to look no further than the originally-filed drawing to understand that applicant’s concept involved a metatarsal guard having no spaces therein. Nevertheless, to place the application in condition for allowance or in better form for appeal, the reference to the metatarsal guard having no slits therein has been deleted from the claims.

B. Claims 4-6 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. In view of the present amendment, and for the reasons expressed in section A above, it is respectfully requested that the rejection of claims 4-6 be withdrawn.

C. Claims 4-7 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fortin et al. (5457898).

It is the Examiner's contentions that Fortin et al. "clearly shows a 'single leg', the rear portion of the sides shown in the figures, the front elements could be considered to be a 'brace' or forward support," and further that "the guard of Fortin et al. does not contain any slits within the interior of the periphery of the guard, i.e. the actual guard is a solid piece of material within [no] slits or holes within the device".

It is respectfully submitted that these contentions are based on an incorrect interpretation of Fortin et al. Fortin et al. state that their metatarsal guard is "made of a sheet" of robust, slightly flexible plastic material" (col. 2, lines 38, 39) and that the "plastic sheet" comprises a right lateral edge surface 13 and a left lateral edge surface (not shown) both resting on the top surface of the sole 12 of a safety boot 14" (col. 2, lines 50 to 53).

Accordingly, the guard includes the right lateral edge surface 13, and not merely a portion of the right lateral edge surface 13. Further, in Figure 1 of Fortin et al., it is clearly seen that the right lateral edge surface 13 consists of both that which the Examiner describes as the "rear portion of the sides," and also that which the Examiner describes as the "brace" or "forward support." In view of the foregoing, it is submitted that there is no basis for the Examiner's contention that the "brace" or "forward" support is not part of the "actual guard."

In summary, because Fortin et al.'s guard does not have only a single concave right support leg and a single left support leg as recited in claims 4-7, it is respectfully submitted that the rejection of claims 4-7 should be withdrawn.

C. Claims 4-7 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Fortin et al. It is the Examiner's contention that "it would have been obvious to remove the flexibility elements / cuts (19 and 20) from the guard of Fortin et al. to provide a stronger, stiffer, less expensive guard and shoe".

But flexibility elements / cuts 20 go to the essence of Fortin et al.'s invention. Thus, it is stated in the Summary of Invention that the "rear impact-absorbing portion comprises longitudinal slits [20] forming in the sheet material a transversal series of longitude tongues capable of spreading apart from each other to follow the movement of the foot when the wearer is walking" (col. 1, lines 53 to 57). So too, with respect to flexibility elements / cuts 19 it is stated in the Summary of Invention that the "two slits [19] cut in the sheet material and extending transversely of the wearer's foot from the two lateral edge surfaces, respectively, ...facilitate the flexion of the metatarsal guard and prevent this guard from impeding flexion of the foot of the wearer in a crouching posture" (col 1, line 64 to col. 2, line 1).

In view of the foregoing, because the Examiner's proposed interpretation of Fortin et al. would remove the ability of the longitudinal tongues to spread apart from each other to follow movement of the foot when the wearer is walking, and because the proposed interpretation would remove the ability of the two lateral edge surfaces to enable flexion of the wearer's foot in the crouching posture, it is respectfully submitted that the rejection of claims 4-7 under 35 U.S.C. 103(a) as being unpatentable over Fortin et al. should be

withdrawn.


D. Claims 8-12 have been added to further define applicant's invention.

Conclusion

The relatively complex metatarsal guard of Fotin et al, indicates that the patentees did not recognize that the simple metatarsal guard of the present invention would meet the industrial requirements for impact resistant safety shoes and also provide the required flexibility to the wearer of a safety shoe. For all the foregoing reasons, it is respectfully submitted that claims 4-7 are patentable over the prior art of record.

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Respectfully submitted,



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